2613

Docket No.: JANCO 3.0-001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

4 Resp 32703

In re Patent Application of:
Gilman et al

Application No.: 09/579,030 Group Art Unit: 2613

Filed: May 26, 2000 Examiner: Nhon Diep

For: KITCHEN APPLIANCE WITH VIDEO DISPLAY

Commissioner for Patents
Washington, DC 20231

RESPONSE

Dear Sir:

In response to the Official action mailed December 18, 2002, Applicant respectfully requests reconsideration of each and every rejection therein.

Initially, the Examiner has rejected claims 1, 2, 4, 5 and 7-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,926,168 to *Fan*.

To place this rejection in context, Applicant briefly reviews the requirements of § 102(b) of the U.S. Patent and Trademark Laws. Specifically, § 102(b) requires a complete anticipation of each and every element in a claim. That is, each and every element within a claim must be specifically present within the cited § 102(b) reference. The absence of even a single element within a claim defeats the § 102(b) reference.

The *Fan* reference does not include each and every element of claims 1, 2, 4, 5, or 7-12. The Examiner refers to Fig. 11b in *Fan*, as well as column 26, line 57 through

column 27, line 17. However, these portions of *Fan* do not support the Examiner's position that each and every element of the rejected claims is disclosed in *Fan*.

For instance, while the excerpt at columns 26 and 27 refer to a "microprocessor based home appliance 30," it is further defined as a device "which can be either an interactive TV or other interactive home electronics." And elsewhere in the specification, the reference numeral 30 is defined as a "microprocessor based machine 30" (col. 5, lns. 58-59), and as an "interactive TV or computer 30" (col. 26, ln. 25). There is not even the suggestion which—would be improper to refer to on a § 202 analysis in any event—that the device is a kitchen appliance such as those defined in the present application. Any reliance on the mention of "kitchen" at column 27, line 13 is misplaced, insofar as the kitchen has been and will continue to be a location in a home where TVs and computers are commonly used. Indeed, one of the instigations for the present invention is based on this reality. It follows, of course, that the mere mention of a "microprocessor-based home appliance 30," together with the mention of an "interactive TV or computer 30" and a "microprocessor based machine 30," does not reveal a "kitchen appliance" as set forth in any of the rejected claims.

Moreover, the Examiner has made an assumption that the face of the box shown in Fig. 11b is a door. Nothing within the *Fan* patent indicates that this is the case. Rather, reference 20 is a "display means 20" and reference 46 is a "receiver 46." Reference 10 is a "cursor 10." Thus, the *Fan* reference is missing—at the very least—a display in a door, as called for in claim 1, and all claims depending therefrom, including rejected dependent claims 2, 4, 5 and 7-9.

With further reference to Fig. 11b of the *Fan* reference, nowhere in the description of Fig. 11b is there an

indication that the "microprocessor based home appliance 30," "interactive TV or computer 30," or "microprocessor based machine 30" has an apparatus for effecting the environment of an anterior. Indeed, one cannot even know what the interior of device 30 is in he *Fan* reference, as it is never disclosed. It is essentially a black box depiction. Accordingly, this aspect of independent claims 10 and 16, as well as the claims depending therefrom, is not disclosed in *Fan*.

None of the above is surprising given the fact that the *Fan* reference is concerned with remote pointers, not the subject matter of the present application.

In light of the above, Applicant respectfully requests the Examiner to withdraw the § 102 rejection of claims 1, 2, 4, 5 and 7-12 over *Fan*.

The Examiner has also rejected claims 15 and 16 under § 103(a) as being obvious in view of the *Fan* patent. The Examiner has admitted that *Fan* does not disclose a display cover. The only support for this § 103 rejection is the Examiner's statement that one of ordinary skill in the art at the time the invention was made would obviously have provided covering for a television display as a means to protect the display in a kitchen area. Applicant respectfully traverses this rejection.

To place this rejection in context, Applicant notes that § 103 of the U.S. Patent laws require an Examiner to show that a reference or references teach the claimed invention. Significantly, the Examiner cannot use hindsight in presenting a § 103 rejection. To do so would be to improperly use the Applicant's disclosure as a blueprint for picking and choosing elements from various prior art references. Moreover, an Examiner must point to a specific suggestion to combine teachings of a reference or references or point to a specific

motivation to modify a reference or references in order to arrive at the claimed invention.

If the § 103 analysis was not rigorous enough, the statute and case law also require that the reference or references reveal the claimed invention to one of ordinary skill in the art at the time the invention was made. Thus, the hypothetical one of ordinary skill in the art is the benchmark against which the above requirements of a specific suggestion or motivation are judged.

Applicant respectfully submits that there is no *prima facie* case in the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) over *Fan*. First, the foregoing with respect to the *Fan* reference and its applicability as a § 102 reference reveals that *Fan* does not provide everything in claims 15 and 16 but for the display cover. Rather, before even considering the display cover, the foregoing reveals that *Fan* fails as a reference in the § 102 rejection, as well as in the present § 103 rejection. The inquiry need go no further. However, it is also noted that the Examiner's mere supposition that a display cover would be provided for a device in a kitchen is without support in the *Fan* reference or any other reference cited by the Examiner. This mere supposition reveals that the Applicant's disclosure was used to develop the rejections. To take this one final step, TV monitors and computers are commonly used in kitchen areas, yet the use of display covers is not prevalent.

Accordingly, Applicant respectfully requests that the rejection of claims 15 and 16 under § 103(a) over *Fan* be withdrawn.

The final rejection by the Examiner is a rejection of claims 3, 6, 13, 14 and 17 under § 103(a) as being obvious over

the *Fan* patent in view of U.S. Patent No. 4,628,351 to *Heo*. Applicant respectfully traverses this rejection.

Reference is made to the above requirements of § 103. These requirements are equally pertinent to the analysis of the present rejection over *Fan* in view of *Heo*, and believed to be dispositive of the rejection, revealing that no *prima facie* rejection has been presented by the Examiner.

First and foremost, the present rejection relies entirely on the application of *Fan* to the independent claims from which the rejected claims depend. Thus, the analysis set forth above with respect to the § 102 rejection is dispositive of the present § 103 rejection. To the extent properly combinable, the *Fan* and *Heo* patents together do not reveal the present invention as set forth in the independent claims. Accordingly, for this reason alone, the present § 103 rejection of claims 3, 6, 13, 14 and 17 fails to reach the level of a *prima facie* rejection. Applicant thus respectfully requests that it be withdrawn.

Moreover, the Examiner admits that the *Fan* reference does not disclose those elements added by the specific dependent claims 3, 6, 13, 14 and 17. The Examiner relies on *Heo* in order to provide that which the Examiner admits is missing from *Fan*. As noted above, this already fails as the *Fan/Heo* combination, to the extent appropriate, and fails to teach that which is in the independent claims from which the dependent claims depend. With respect to claims 13 and 14, the Examiner admits that the *Fan* patent does not teach the additional elements set forth therein—*i.e.*, those provided over claim 10 from which these claims depend. The Examiner does not, however, implicate *Heo* insofar as *Heo* would clearly be of no help here as well. Instead, as with the rejection of claims 15 and 16, the Examiner has simply made the statement that it would have been obvious to

one of ordinary skill in the art at the time the invention was made to place the displayed device of *Fan* on the front or side of a refrigerator. No suggestion is made in the *Fan* patent or the *Heo* patent (which is not applied here anyway) in order to arrive at this conclusion. There being simply no explanation of how or why one of ordinary skill in the art would have found the present invention to be obvious, the § 103 rejection fails to be a *prima facie* rejection.

Accordingly, Applicant respectfully requests that this § 103 rejection be withdrawn.

Applicant, having addressed all outstanding issues in connection with this application, earnestly solicits favorable action in the form of a Notice of Allowance of all claims. No fees are due and owing by reason of this Amendment, nor are any extension fees due and owing by reason of this Amendment, however, should the Examiner believe that some fees are due and owing, the Examiner is authorized to charge Deposit Account 12-1095 therefor, with an adequate explanation of the fees being charged.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

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Respectfully submitted,

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